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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/071,526	02/08/2002	Jonathan A. Forbes	3382-61916	2616
26119	7590	11/29/2004	EXAMINER	
KLARQUIST SPARKMAN LLP 121 S.W. SALMON STREET SUITE 1600 PORTLAND, OR 97204			RAMPURIA, SATISH	
			ART UNIT	PAPER NUMBER
			2124	

DATE MAILED: 11/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/071,526

Applicant(s)

FORBES ET AL.

Examiner

Satish S. Rampuria

Art Unit

2124

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>02/08/02</u> .  | 6) <input type="checkbox"/> Other: _____                                    |

***DETAILED ACTION***

1. This action is in response to the application filed on 02/08/2002.
2. Claims 1-31 are pending.

***Specification***

3. The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code, e.g., page 28, lines 21-22. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code, wherever it appears. See MPEP § 608.01.
4. The use of the trademark "Java" has been noted in this application. It should be appropriate or proper term (see MPEP 608.01(v)) used, wherever it appears and be accompanied by the generic terminology. Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.  
  
Appropriate correction is required

***Information Disclosure Statement***

5. An initialed and dated copy of Applicant's IDS form 1449 filed on 02/08/2002 is attached to the instant Office action.

***Claim objections***

6. Claim 10 is objected to because of the following informalities:

Claim 10 contains the trademark/trade name Java. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, See Ex parte Simpson, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112, second paragraph***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Clarification and/or correction are required.

Claim 10 contains the trademark/trade name Java. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See Ex parte Simpson, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a

Art Unit: 2124

trademark or trade name does not identify or describe the goods associated with the trademark or trade name.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1-9 and 11-29 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 5,586,304 to Stupek, Jr. et al. (hereinafter called Stupek).

**Per claims 1, 9, and 11:**

Stupek disclose:

- determining whether software associated with the software dependency is present on the computer (col. 6, lines 24-25 "The database also contains information regarding the dependencies"); and
- responsive to determining the software associated with the software dependency is not present on the computer, acquiring the software associated with the software dependency (col. 6, lines 45-48 "dependency information in the Package database 25 describes not

Art Unit: 2124

only the dependencies between packages on the CD, but also all dependencies between an upgrade package and any upgrade not available on the CD”);

- wherein at least one of the software dependencies refers to a list comprising one or more other software dependencies (col. 6, lines 24-31 “child dependencies 25h are the upgrade objects associated with a package; sibling dependencies 25j are the packages upon which a package depends; and parent dependencies”).

**Per claim 2:**

The rejection of claim 1 is incorporated, and further, Stupek disclose:

- wherein acquiring the software associated with the software dependency comprises acquiring a file comprising the list comprising one or more other software dependencies (col. 6, lines 24-26 “The database also contains information regarding the dependencies between the package and other upgrade objects or packages”).

**Per claim 3 and 4:**

The rejection of claim 1 is incorporated, and further, Stupek disclose:

- wherein acquiring the software associated with the software dependency comprises acquiring a list of one or more files from a remote location and acquiring the files in the list (col. 3, lines 56-58 “the upgrade device 10 automatically analyzes each network resource 3 currently on the server 1 to determine the availability and necessity of the corresponding upgrade 7”).

**Per claims 5 and 6:**

The rejection of claim 1 is incorporated, and further, Stupek disclose:

- after acquiring the software associated with the software dependency (col. 7, lines 50-53 “collecting information about the corresponding package... pointers to parent, child and sibling packages”), updating a database at the computer indicating the software associated with the software dependency is installed on the computer (col. 7, lines 5-10 “Within the How\_To database, each record represents an individual piece of MIB information corresponding to the particular package... upgrade device... specified in the record”), wherein the database is operable to indicate whether a plurality of software components are installed via a single name associated with the plurality of software components (col. 6, lines 24-26 “The database also contains information regarding the dependencies between the package and other upgrade objects or packages”).

**Per claims 7 and 8:**

The rejection of claim 1 is incorporated, and further, Stupek disclose:

- one or more dependencies in the list of software dependencies is associated with a version number (col. 4, lines 24-28 “upgrade advisor places information about the resource (e.g., name, version number) into a driver table...the server manager located in the server uses this information to search for the resource (i.e., to see if the resource has been installed on the network”); and
- determining the dependency is not present on the computer comprises determining software satisfying the version number is not present on the computer (col. 1, lines 60-62

“storing upgrade information which identifies the later version and describes features of the later version relative to one or more earlier version”).

**Claim 12** is the computer program product claim corresponding to method claim 1 and rejected under the same rationale set forth in connection with the rejection of claim 1 above.

**Per claims 13 and 14:**

Stupek disclose:

- specifying a name of the software dependency (col. 6, line 24-25 “database contains information regarding the dependencies”);
- wherein the name is operable to identify a list of one or more other software dependencies (col. 6, lines 24-31 “child dependencies 25h are the upgrade objects associated with a package; sibling dependencies 25j are the packages upon which a package depends; and parent dependencies”).

**Per claim 15:**

The rejection of claim 13 is incorporated, and further, Stupek disclose:

- wherein the software dependency is associated with a software package depending on at least one other software package (col. 6, lines 24-26 “database... contains information... dependencies between the package and other upgrade objects or packages”).

**Per claim 16:**



The rejection of claim 13 is incorporated, and further, Stupek disclose:

- comparing the version for the software dependency against a version of software installed at a computer (col. 4, lines 5-7 “The upgrade advisor 11 then retrieves upgrade information from the upgrade database 9 and performs two types of comparisons”); and
- responsive to determining the version installed at the computer is not sufficient, acquiring the version for the software dependency (col. 3, lines 56-58 “upgrade device 10 automatically analyzes each network resource 3 currently on the server 1 to determine the availability and necessity of the corresponding upgrade 7”).

**Per claims 17, 18, 19, 20, 22, and 23:**

Stupek disclose:

- consulting a database to see if software associated with the name is already installed at the computer (col. 4, lines 7-12 “a) whether or not a particular upgrade package corresponds to a resource on the server, and b) whether or not the version number of the upgrade package matches the version number of the corresponding network resource (i.e., whether or not the upgrade package represents a true upgrade for the existing network resource)”); and
- responsive to determining software associated with the name is not already installed at the computer, acquiring the specified software (col. 3, lines 56-58 “upgrade device 10 automatically analyzes each network resource 3 currently on the server 1 to determine the availability and necessity of the corresponding upgrade 7”);

Art Unit: 2124

- wherein the name is operable to specify a plurality of software components (col. 6, lines 24-31 “child dependencies 25h are the upgrade objects associated with a package; sibling dependencies 25j are the packages upon which a package depends; and parent dependencies”).

**Per claim 21:**

The rejection of claim 17 is incorporated, and further, Stupek disclose:

- wherein acquiring the specified software comprises recursively processing software dependencies associated with the name to find one or more other software dependencies associated with names designating software (col. 4, lines 13-17 “If the upgrade applies to a resource on the server and if the upgraded and current versions of the network resource do not match, the upgrade advisor 11 uses additional information from the upgrade database 9 to analyze the level of severity of the upgrade”).

**Claims 24 and 26** are the computer program product claim corresponding to method claim 17 and rejected under the same rational set forth in connection with the rejection of claim 17 above.

**Claim 25** is the computer program product claim corresponding to method claim 20 and rejected under the same rational set forth in connection with the rejection of claim 20 above.

**Claim 27** is the computer program product claim corresponding to method claim 1 and rejected under the same rational set forth in connection with the rejection of claim 1 above.

**Claim 28** is the system claim corresponding to method claim 17 and rejected under the same rational set forth in connection with the rejection of claim 17 above.

Art Unit: 2124

*Claim 29* is the system claim corresponding to method claim 26 and rejected under the same rational set forth in connection with the rejection of claim 26 above.

Substantially as claimed.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 10, 30, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stupek in view of US Patent No. 6,802,061 to Parthasarathy (hereinafter called Parthasarathy).

**Per claim 10:**

Stupek does not explicitly disclose software package comprises a mixture of native code components and Java classes.

However, Parthasarathy discloses in an analogous computer system software package comprises a mixture of native code components and Java classes (col. 3, lines 18-24 “any software component can be downloaded, verified, and installed... whether it is JAVA class library...”).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate the method of downloading any software components as

Art Unit: 2124

taught by Parthasarathy into the method of upgrading the computer as taught by Stupek. The modification would be obvious because of one of ordinary skill in the art would be motivated to have the mixture of software package components to provide versatile types of updates as suggested by Parthasarathy (col. 3, lines 42-49).

**Per claim 30:**

Stupek does not explicitly disclose wherein the other list of dependencies is specified via an URL.

However, Parthasarathy discloses in an analogous computer system wherein the other list of dependencies is specified via an URL (col. 3, lines 14-6 “software component download module for locating computer software components with uniform resource locators (URLs)”).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate the method of downloading any software components using URLs as taught by Parthasarathy into the method of upgrading the computer as taught by Stupek. The modification would be obvious because of one of ordinary skill in the art would be motivated to have the URLs of software package components to provide versatile types of updates as suggested by Parthasarathy (col. 3, lines 42-49).

**Per claim 31:**

Stupek does not explicitly disclose comprising a browser; wherein the software package manager is operable to initiate execution of a software package as directed by the browser upon encountering HTML tags indicating the specified list of dependencies.

However, Parthasarathy discloses in an analogous computer system comprising a browser; wherein the software package manager is operable to initiate execution of a software package as directed by the browser upon encountering HTML tags indicating the specified list of dependencies (col. 3, lines 34-38 “When the <OBJECT> tag is encountered in a HTML document during browsing with a network browser, the multimedia software components referenced by the <OBJECT> tag are automatically downloaded and displayed directly on user’s computer”).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate the method of downloading any software components using HTML tags as taught by Parthasarathy into the method of upgrading the computer as taught by Stupek. The modification would be obvious because of one of ordinary skill in the art would be motivated to have the HTML tags of software package components to provide versatile types of updates as suggested by Parthasarathy (col. 3, lines 42-49).

### ***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Satish S. Rampuria** whose telephone number is (571) 272-3732. The examiner can normally be reached on **8:30 am to 6:00 pm**.

Art Unit: 2124

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Kakali Chaki** can be reached on (571) 272-3719. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Satish S. Rampuria  
Patent Examiner  
Art Unit 2124  
11/29/2004

  
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